

**UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

WILUS INSTITUTE OF STANDARDS AND
TECHNOLOGY INC.,

Plaintiff,

v.

HP INC.,

Defendant.

Case No. 2:24-cv-00752-JRG

Lead Case

WILUS INSTITUTE OF STANDARDS AND
TECHNOLOGY INC.,

Plaintiff,

v.

SAMSUNG ELECTRONICS CO., LTD. and
SAMSUNG ELECTRONICS AMERICA,
INC.,

Defendants.

Case No. 2:24-cv-00746-JRG

WILUS INSTITUTE OF STANDARDS AND
TECHNOLOGY INC.,

Plaintiff,

v.

SAMSUNG ELECTRONICS CO., LTD. and
SAMSUNG ELECTRONICS AMERICA,
INC.,

Defendants.

Case No. 2:24-cv-00765-JRG

**NOTICE OF SUPPLEMENTAL AUTHORITY IN SUPPORT OF MOTION TO DISMISS
SAMSUNG'S AMENDED COUNTERCLAIMS 1-2**

Plaintiff and Counterclaim Defendant Wilus Institute of Standards and Technology Inc. (“Wilus”) hereby provides this notice of supplemental authority in support of its motion to dismiss Samsung’s amended counterclaims 1–2 (Dkt. 116).

On July 22, 2025, in *Roku, Inc. v. Access Advance LLC*, No. 1:24-cv-13217-RGS (D. Mass.), the court entered a series of orders granting defendants’ motion to dismiss and dismissing the case in its entirety. *Id.* Dkt. Nos. 51–53. Like the present case, *Roku* involved patents that were part of a patent licensing pool. One of the grounds for the motion to dismiss was that the court lacks subject matter jurisdiction to declare a FRAND rate for global patent portfolios because it “would require this Court to determine royalties due on foreign patents and patents owned by dozens of parties not before the Court.” *Id.* Dkt. 32 at 1–2, 12–13.

In the minute order at Dkt. 52, the court found: “The court lacks jurisdiction to determine the FRAND rate as requested in Count IX. The U.S. patents constitute only a fraction of the larger portfolio which includes hundreds of foreign patents[,] and the court’s opinion on the appropriate royalty rate would merely be advisory.”

Here, as in *Roku*, Samsung’s counterclaims improperly seek determinations of FRAND terms on foreign patents. Although *Roku* involved declaratory judgment claims, the Court’s reasoning that it “lacks jurisdiction” to make determinations with respect to foreign patents still applies to Samsung’s breach of contract counterclaims, as those claims similarly require determining whether Wilus complied with its obligations regarding foreign patents in Sisvel’s patent pool. Accordingly, the *Roku* decision further supports dismissal of Samsung’s counterclaims.

Dated: July 23, 2025

Respectfully submitted,

/s/ Neil A. Rubin

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CERTIFICATE OF SERVICE

I certify that on July 23, 2025, a true and correct copy of the foregoing document was electronically filed with the Court and served on all parties of record via the Court's CM/ECF system.

/s/ Neil A. Rubin